

5.1022

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	
ETSUO OSHIMA, ET AL.)	Examiner: Richard L. Raymond
Serial No.: 020,900)	Group Art Unit: 129
Filed: March 2, 1987)	
For: DIBENZ [b,e] OXEPIN)	
DERIVATIVE)	September 13, 1991

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The Honorable Commissioner of Patents
and Trademarks
Petitions Information,
Crystal Park 2, Suite 913
Washington, D.C. 20231

DEPUTY ASST. COMM.

REQUEST FOR WITHDRAWAL OF
ERRONEOUS NOTICE OF ABANDONMENT

Sir:

Applicants respond to the Examiner Communication dated April 17, 1990 (Paper No. 16) in the above-identified application as follows.

REMARKS

The April 17, 1990 Examiner Communication states that this application was abandoned due to Applicants alleged failure to copy, for the purpose of provoking an interference, Claim 1 of U.S. Patent No. 4,871,865. Such statement is incorrect in view of the express provisions at

M.P.E.P. §§ 2305.01 and 2305.02. For instance, M.P.E.P.

§ 2305.01 states that

If the applicant does not present the suggested claim by the expiration of the period fixed for its presentation, the Examiner should then reject those claims which were previously stated as being unpatentable over the suggest claim.
(Emphasis added)


Therefore, the Notice of Abandonment was issued contrary to the Rules and should be withdrawn. Accordingly, withdrawal of the erroneous Notice of Abandonment and issuance of an Office Action in conformity with M.P.E.P. §§ 2305.01 and 2305.02 are earnestly solicited.

Applicants' undersigned attorney may be reached by telephone in our New York Office at

(212) 758-2400.

All correspondence should continue to be directed to our below listed address.

Respectfully submitted,


Lawrence S. Perry
Attorney for Applicants
Registration No. 31,865

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F508/A59254/ec

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150, 141 A/d #18
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DEPUTY ASST. COMM.

1371

PETITION FOR THE REVIVAL OF AN
UNINTENTIONALLY ABANDONED APPLICATION
UNDER 37 C.F.R. § 1.137

Sir:

Applicants hereby petition the Deputy Assistant
Commissioner for Patents to revive the unintentionally
abandoned United States national patent application
identified above. Enclosed herewith is a check in the amount
of \$1,050.00 to cover the petition fee under 37 C.F.R.
§ 1.17(m)(2) and proposed response. The undersigned hereby
authorizes the Commissioner to charge any deficiencies in
connection with this Petition, or credit any overpayment, to
deposit account No. 06-1205.

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INTRODUCTION

This application was filed on March 2, 1987. The application was prosecuted to allowable condition when, on October 7, 1988, Applicants received an Examiner Communication suspending ex parte prosecution for a period of six (6) months due to a possible interference. After six months had passed, in response to a Status Inquiry dated August 15, 1989, Applicants ultimately received a Notice dated September 6, 1989 suspending prosecution for an additional six months. Thereafter, on April 17, 1990, Applicants received an Examiner Communication (Paper No. 16), withdrawing the September 6, 1989 suspension and suggesting that Applicants exactly copy Claim 1 of United States Patent No. 4,871,865 (the "suggested claim") for purposes of an interference. The April 17, 1990 Communication stated that Applicants should make the suggested claim within one month and that failure to do so will be considered a disclaimer of the subject matter thereof under the provisions of 37 C.F.R. § 1.605(a). The Examiner stated further that Claims 1-10 and 13-19 were considered to be unpatentable over the suggested claim. None of Applicants' Claims 1-10 or 13-19 was identical to the suggested claim.

Applicants did not copy the suggested claim and did not file a response to the April 17, 1990 Examiner Communication. On November 19, 1990, Applicants received a Notice of Abandonment (Paper No. 17) stating that this

application was abandoned in view of "Applicants' failure to respond to the Office Letter, mailed April 17, 1990."

ARGUMENT

There was no requirement that Applicants file a response to the April 17, 1990 Examiner Communication.

Rather, the Examiner Communication states quite clearly:

Applicant should make the suggested claim within one month from the date of this letter. Failure to do so will be considered a disclaimer of the subject matter of this claim under the provisions of 37 C.F.R. § 1.605(a).

That is, if participation in an interference with U.S. Patent No. 4,871,865 was not desired, Applicants could remain silent and elect not to copy the suggested claim. Under the Rules, Applicants' silence would have amounted to an admission that the suggested claim is prior art to the present application, and an Office Action rejecting the pending claims over the suggested claim would be issued shortly thereafter.

The provision establishing that Applicants did not have to copy the suggested claim is outlined in M.P.E.P.

§ 2305.01 (Action To Be Made at Time of Suggesting Claims):

If the applicant does not present the suggested claim by the expiration of the period fixed for its presentation, the examiner should then reject those claims which were previously stated as being unpatentable over the suggested claim on the basis that the failure to present constituted a concession that the subject

matter of those claims is the prior invention of another in this country.

Accord, see M.P.E.P. § 2305.02 (Time Limit Set for Presenting Suggested Claims) which states that

Should any one of the applicants fail to present the claim or claims suggested within the time specified, all claims not patentable thereover are rejected on the ground that the applicant has disclaimed the invention to which they are directed.

Nonetheless, the Patent and Trademark Office incorrectly abandoned the present application by issuing the November 19, 1990 Notice of Abandonment contrary to the requirements of M.P.E.P. § 2305.01 and 2305.02.^{1/} Accordingly, since issuing the Notice of Abandonment on November 19, 1990 was clearly improper, Applicants' abandonment of this application on that date was obviously unintentional.

^{1/} Applicants note that it would have been proper to issue a Notice of Abandonment only in the instance that the suggested claim was not presented within the time specified and an Office Action remained outstanding against the case at the time of suggesting the claims and Applicants filed no amendment responsive to such Office Action. M.P.E.P. § 2305.03 (Suggested Claims Presented After Period for Response Running Against Case). Such was, of course, not the situation in the instant application since there was no Office Action outstanding against the case at the time of suggesting the claims. The Examiner did not make any provisional rejections in the April 17, 1990 Communication. Moreover, the previous non-final Office Action dated April 21, 1988 (Paper No. 8) was fully responded to on August 2, 1988 by the filing of a Petition for Extension of Time, Amendment and Submission of Certified Translation.

In view of the above, Applicants submit that the present Petition is in conformity with 37 C.F.R. § 1.137(b) as discussed at M.P.E.P. § 711.03(c):

Generally, a statement that the abandonment was unintentional, plus the proper petition fee, and the proposed response is all that is required. A description of the circumstances surrounding the unintentional abandonment may be provided by applicant so that the record clearly reflects that the abandonment was unintentional.

In this regard, Applicants chose not to become involved in an interference with the 4,871,865 patent while retaining the opportunity to establish the separate patentability of various species disclosed in the present application over the suggested claim if and when a rejection was made. Applicants did not choose to abandon their application.

CONCLUSION


Accordingly, in view of the fact that abandonment of this application was clearly unintentional as described above and since this Petition is accompanied by both the proper petition fee and proposed response, revival to pending status of this application is earnestly solicited.

Applicants' undersigned attorney may be reached by telephone in our New York Office at

(212) 758-2400.

All correspondence should continue to be directed to our
below listed address.

Respectfully submitted,


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